

**REMARKS**

Claims 2-3, 5-9, 11-18, and 20-35, and 37-60 are pending in this application after this Amendment; claims 28, 32, 37, and 41 being independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

**Official Action**

In the outstanding Official Action, the Examiner rejected claims 4, 7, 13, 16, 22, 26, 29, 32, 35, 37, 39, 41, 44, and 46 under 35 U.S.C. § 112, second paragraph; and rejected claims 2-9, 11-18, and 20-48 under 35 U.S.C. § 103(a) as being unpatentable over *Enomoto et al.* (USP 5,974,401) in view of *Garfinkle* (USP 6,017,157). Applicants respectfully traverse these rejections.

**Examiner Interview**

Applicants wish to thank the Examiner for the interview conducted on April 15, 2003. It is respectfully submitted that the amendments and remarks made herein are consistent with the discussions had during the interview.

**Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 7, 16, 26, and 29 under 35 U.S.C. § 112, second paragraph, asserting Applicants do not indicate what actions by a user are required in order to complete an order. It is respectfully submitted that the terms set forth in the claims are fully explained and defined in the specification, for example, on page 5, lines 25-28; page 8, lines 23-28; etc. As such, it is respectfully submitted that the specification clearly defines when an order is complete. As such, it is respectfully requested that the outstanding rejection be withdrawn.

The Examiner additionally rejected claims 4, 13, 22, 32, 35, 37, 39, 41, 44, and 46 under 35 U.S.C. § 112, second paragraph, asserting the term "ordering information" does not appear in the disclosure and is not defined by the claims. It is respectfully submitted that "ordering information" is clearly defined in the specification, for example, on page 6, lines 13-17; page 7, line 29 - page 8, line 1; and page 8, lines 21-22. Further, it is respectfully submitted that one of ordinary skill in the art can appreciate what other types of information would constitute ordering information. As such, it is respectfully requested that the outstanding rejection be withdrawn.

#### **Claim Rejections - 35 U.S.C. § 103**

By this Amendment, Applicants have amended at least independent claims 28, 32, 37, and 41 to more appropriately recite the present invention. It is respectfully submitted that these amendments are made without conceding the propriety of the Examiner's rejection, but merely to timely advance the prosecution of the present invention.

With regard to the Examiner's rejection of claim 28, the Examiner asserts that the use of shells and shell extensions are well-known file system interfaces and, thus, it would have been obvious to combine the teachings of *Enomoto et al.* with shell extensions to teach the invention set forth in claim 28. Applicants respectfully disagree with the Examiner's combination of these teachings. While Applicants admit that a Windows operating system utilizes a shell to provide for the interaction between the user and the computer, it is respectfully submitted that a shell extension to facilitate an order of image-related services is not inherent in a Windows operating system and, further, it is not well known to incorporate a shell extension to facilitate the ordering of image-related services. Additionally, neither *Enomoto et al.* nor *Garfinkle* teaches or

suggests an operating system that includes a shell extension for facilitating an order of image-related services as recited in claim 28. As such, it is respectfully requested that the outstanding rejection of claim 28, together with claims dependent thereon, be withdrawn.

With regard to the Examiner's rejection of claim 32, by this Amendment, Applicants have amended the claim to recite "uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information." It is respectfully submitted that *Enomoto et al.* discloses a digital print order and delivery method and system. *Enomoto et al.* discloses at col. 6, ll. 10-18:

Upon user's request for downloading sent from the connected personal computer 11 on the user side 10, the work station 13 of the photofinisher 12 sends out the image processing-ordering software to the personal computer 11 of the user side 10. The user 10 extracts the downloaded image processing-ordering software and installs it in the personal computer 11. If the installation is accomplished normally, a user registration menu appears, which helps the user register for the print order.

Additionally, *Enomoto et al.* discloses that upon receipt of an accept number and a message of acceptance at the personal computer 11, the user selects or designates the order execution after confirming the delivery date and the charge on the screen and then sends the entire print order data to the work station 13. The entire print order data is constituted of all the print order data and the image data for the print (col. 7, ll. 13-19).

It is respectfully submitted that *Enomoto et al.* fails to disclose updating the digital image to the external network entity or another external network entity subsequent to exchanging all ordering information. It is respectfully submitted that *Garfinkle* fails to cure the deficiencies of the teachings of *Enomoto et al.* (assuming these references are combinable, which Applicants do not admit), as *Garfinkle* fails to teach or suggest this

element of claim 32. As such, it is respectfully submitted that claim 32, together with claims dependent thereon, are allowable over the art as cited by the Examiner.

It is respectfully submitted that claims 37 and 41 contain elements similar to those discussed above with regard to claim 32 and, thus, claims 37 and 41, together with claims dependent thereon, are not obvious over *Enomoto et al.* in view of *Garfinkle*.

### CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number below.

Pursuant to the provisions of 37 C.F.R. § 1.17 and § 1.136(a), Applicant hereby petitions for an extension of one (1) month in which to file a response to the outstanding Office Action. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner of hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version With Markings to Show Changes Made

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claims 4 and 36 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

The claims have been amended as follows:

28. (Twice Amended) A network photo print system, comprising:

a user station, capable of running

a camera/scanner applications program for supplying first image data to the user station,

a photo editing applications program for supplying second image data to the user station,

an operating system, including an operating system desktop shell interface and an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station, wherein the shell extension is capable of facilitating an order, and

a network access protocol module capable of receiving any one of the first, second, and third image data, receiving order and merchandise availability information from an external network entity; processing [an] the order based on any one of the first, second, and third image data, and outputting any one the first, second, and third image data;

a network sales/order processing server for receiving the order and for receiving any one the first, second, and third image data image data from the user station after receiving the order; and

a photofinishing lab for producing photographic-quality prints images based on the order and any one the first, second, and third image data from the network sales/order processing server.

32. (Twice Amended) A method of on-line ordering of image-related services, comprising:

receiving, at a user station, a digital image;

establishing a network connection between said user station and an external network entity;

accessing an application at the external network entity through the network connection;

exchanging ordering information, between said user station and said external network entity after accessing the application at the external network entity, for an image-related service for said digital image; and

uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information.

34. (Amended) The method of claim 49[32], wherein

said user station receives said digital image using [a] the shell extension of an operating system to access said digital image from a file system.

37. (Twice Amended) A computer program embodied in a computer-readable medium for on-line ordering of image-related services, comprising:

a receiving code segment for receiving, at a user station, a digital image;

a network connection code segment for establishing a network connection between said user station and an external network entity;

accessing an application at the external network entity through the network connection;

an ordering code segment for exchanging ordering information, between said user station and said external network entity after accessing the application at the external network entity, for an image-related service for said digital image; and

an uploading code segment for uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information.

41. (New) A computer signal for on-line ordering of image-related services, comprising:

a receiving segment for receiving, at a user station, a digital image;

a network connection segment for establishing a network connection between said user station and an external network entity;

accessing an application at the external network entity through the network connection;

an ordering segment for exchanging ordering information, between said user station and said external network entity after accessing the application at the external network entity, for an image-related service for said digital image; and

an uploading segment for uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information.

New claims 49-60 have been added.